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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,102	04/13/2004	Jan Batzer	104035.277308	6148

7055 7590 03/05/2009

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EXAMINER	
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ART UNIT	PAPER NUMBER
1612	

NOTIFICATION DATE	DELIVERY MODE
03/05/2009	ELECTRONIC

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/824,102
Filing Date: April 13, 2004
Appellant(s): BATZER ET AL.

Niel F. Greenblum
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/08/2008 appealing from the Office action mailed 5/27/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of copending Application no. 10/871,819 has been withdrawn because the co-pending application was abandoned on 9/9/2008.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,705,144	Harding et al.	1-1998
US 6,296,857	Schonrock et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-2 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al., (US 5,705,144) in view of Schonrock et al., (US 6,296,857).

Harding et al. teaches a composition to lighten the skin comprising a dioic acid having the general structure of

$$COOH—(C_aH_b)—COOH,$$

where **a** is an integer from 6 to 20 and **b** is an integer from 8 to 40 (see abstract and col. 2, lines 10-26). The compound 8-hexadecene-1,16-dicarboxylic acid is a species of the dioc acid of Harding et al. where **a** is 16 and **b** is 30. The reference teaches an effective amount of dioic acid from 0.1 to 30% (see col. 3, line 25), as well as adding an antioxidant such as butylated hydroxytoluene, as per claim 2 (claim 11, lines 19-22).

Harding et al. differs from the instant claims insofar as it does not teach where the antioxidant is folic acid.

Schonrock et al. teach a method for cosmetically lightening the skin comprising antioxidants such as folic acid (see col. 1, lin14-21; see also col. 12, lines 49-54, and col. 13, line 14). The composition may or may not include vitamin E, as per claims 5-8 (see col. 13, lines 36-39). The reference teaches that the amount of antioxidant is preferably 0.001 to 30% by weight, as per claim 5, especially preferably 0.05% to 20%, as per claim 6 (see col. 13, lines 32-35).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to have added an antioxidant such as folic acid in the composition of Harding et al, since the antioxidants of Schonrock et al. are used in compositions to lighten large areas of skin. The artisan would have been motivated to provide an antioxidant that poses an advantage in a dermatologic composition used to lighten the skin, as evidenced by Schonrock.

Generally, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. MPEP 2144.05. Since, the ranges of 8-hexadecene-1,16-dicarboxylic acid (claims 9-11) and antioxidant (claims 7 and 8) overlaps with the disclosed prior art ranges a *prima facie* case of obviousness exists.

Non-Statutory Obvious-type Double Patenting

1) Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable of claims 1 and 13 (rewritten as claims 44 and 55) of copending Application 11/087,395 and claims 1 and 5 of copending application 11/547,104.

Claims 1 and 2 are not patentably distinct from claims 44 and 55 of the '395 application and claims 1 and 5 of the '104 application insofar as both copending applications claim cosmetic preparations comprising 8-hexadecene-1,16-dicarboxylic acid and folic acid.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

2) Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51 and 67 of copending Application no. 10/871,861 in view of Schonrock et al, (*supra*). (**The claims of copending application no. 10/871,861 have been patented and are now referenced as claims 1 and 17 of US Patent No. 7,341,712**.)

Claims 1 and 2 are obvious over the claims above insofar as the claims are directed to dermatological preparations comprising 8-hexadecene-1,16-dicarboxylic acid and alpha lipoic acid.

Schonrock et al. provides motivation for adding folic acid as an antioxidant insofar as it poses an advantage in a dermatologic preparation.

2) Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable of claims 1, 18 and 20 of copending application 11/157,946 in view of Schonrock et al, (*supra*).

Claims 1 and 2 are obvious over claims 1, 18 and 20 of the '946 application insofar as the '946 application claims a composition comprising 8-hexadecene-1,16-dicarboxylic acid and lipoic acid.

Schonrock et al. provides motivation for adding folic acid as an antioxidant insofar as it poses an advantage in a dermatologic preparation.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

(10) Response to Argument

Appellant argues that the rejection does not explain why one of ordinary skill in the art would have had an apparent reason to choose 8-hexadecene-1,16-dicarboxylic acid from the host of different dioic acids which are encompassed by the general formula set forth by Harding et al., which is neither expressly mentioned or hinted at in this document. However, 8-hexadecene-1,16-dicarboxylic acid would have been immediately envisaged since it is a compound of structure 2 of Harding where **a** is 16 and **b** is 30. It was explained previously that 8-hexadecene-1,16-dicarboxylic acid is

encompassed by the formula of Harding, and that the compounds of this formula are useful in compositions for topical application to the human skin. As Appellant's invention is drawn to a dermatological composition, it would have been obvious at the time of applicant's invention to use a compound of the formula of Harding in a dermatological composition. Furthermore, applicants provide no evidence of unexpected results in regard to 8-hexadecene-1,16-dicarboxylic acid.

Appellant argues that Harding does not provide how to obtain 8-hexadecene-1, 16-dicarboxylic acid from either a commercial source or by a sythetic route from readily available starting materials. Appellant also argues that Harding et al. lacks any teaching or suggestion to the effect that any of the dioic acids having 16 carbon atoms is an attractive choice as a dioic. However, 8-hexadecene-1, 16-dicarboxylic acid is represented by Harding insofar as it meets the limitations of the formula I. The artisan can simply rely on the formula and examples given in order to make 8-hexadecene-1,16-dicarboxylic acid. Since, 8-Hexadecene-1,16-dicarboxylic acid is a compound of the formula of Harding, the artisan would expect it to function in the same manner as the specific examples.

Appellant also argues that the prior art genus of Harding does not suggest 8-hexadecene-1,16-dicarboxylic acid. However it was previously mentioned that the formula of Harding teaches 8-hexadecene-1,16-dicarboxylic acid where **a** is 16 and **b** is 30.

Appellant argues that because the only example in Harding of an antioxidant is butylated hydroxytoluene, the artisan would understand that antioxidants do not play

any special role for the intended effect of the composition of Harding. However, butylated hydroxytoluene satisfies the limitation of the instant claim 2. Harding clearly stated that antioxidants form the balance of the composition. Nevertheless, the rejection of applicants invention in regard to antioxidants is not relied on by Harding alone. Schonrock, provides motivation for using antioxidants as well at a concentration range which meets or overlaps the concentration ranges of claims 5-8. It should also be noted here that Appellant has not claimed a specific cosmetic or dermatological preparation. Folic acid was an elected species, but the claims read on inclusion of antioxidants in general. Furthermore, Appellant as not given any reason why folic acid would pose any significant advantage over any other antioxidant. Even if such an advantages were to be given, the argument would not be commensurate in scope with the invention as claimed.

Appellant argues that Shonrock does not teach or suggest that antioxidants are critical or even desirable components. However, the use of folic acid or other antioxidants for their conventional advantages are sufficient motivation to add them to the composition Harding. Nevertheless, the fact that applicant has recognized another advantage from the addition of an antioxidant cannot be the basis for patentability.

Appellant argues that there is no motivation to combine Harding and Schonrock since the compositions are entirely different. However, the compositions of Harding and Shonrock claim compositions that are useful in lightening the skin, as per the instant claims. The motivation to combine their teachings stems from this commonality. It would have been obvious in a self-evident manner to select an antioxidant from the list

of adjuncts of Schonrock, motivated by the unambiguous disclosure of these antioxidants, and consistent with the basic principle of patent prosecution that a reference should be considered as expansively as is reasonable in determining the full scope of the contents within its four corners.

Appellant argues that the concentration of dioic acid(s) in the composition of Harding (15% and 20%) is significantly higher than the ranges recited in the instant claims and this is evidence of obviousness over Harding. However, Harding teaches that the concentration can be as low as 0.1% and as high as 30%. Accordingly, the disclosure of Harding includes a composition where the dioic is 1%. Nevertheless, a *prima facie* case of obviousness exists, since the ranges of 8-hexadecene-1,16-dicarboxylic acid (claims 9-11) overlap with the disclosed prior art range. Furthermore, applicant has not provided a rationale for why the claimed ranges poses an advantage over the prior art ranges.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Walter E Webb

/Walter E Webb/

Examiner, Art Unit 1612

Conferees:

/Frederick Krass/

Supervisory Patent Examiner

Art Unit 1612

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611